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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/577,225

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Lundy Lewis

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12/11/2009

PILLSBURY WINTHROP SHAW PITTMAN, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3689

MAIL DATE

DELIVERY MODE

12/11/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/577,225	<b>Applicant(s)</b> LEWIS, LUNDY	
	<b>Examiner</b> Tan Dean D. Nguyen	<b>Art Unit</b> 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-12,30,31 and 34-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,10-12,30,31 and 34-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/4/09</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 09/22/09 has been entered.

### ***Response to Amendment***

2. The amendment filed 9/15/09 has been entered.
- 1) Claims pending: 1, 3-5, 10-12, 30-31, 34-39, 40-54.
  - 2) Claims cancelled: 6-9, 13-29, 32-33.
- They comprise of 2 groups:
- 1) method: 1, 3-5, 10-12, 30-31, 34-39,
  - 2) system: 40-54.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/04/09 was filed after the mailing date of the application on 5/23/00. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Principles of Laws***

4. The preamble is normally considered “being optional” and does not have much patentable weight since many times it is merely statements of purpose or intended use. See MPEP 2111.02 It’s the body of the claim that matters and the current body of the claims have no tie to any particular machine. *Coming Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) (“where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation”); *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ2d at 480-81 (preamble is not a limitation where claim is directed to a product and the preamble merely recites a property inherent in an old product defined by the remainder of the claim); *STX LLC. v. Brine*, 211 F.3d 588, 591, 54 USPQ2d 1347, 1350 (Fed. Cir. 2000) (holding that the preamble phrase “which provides improved playing and handling characteristics” in a claim drawn to a head for a lacrosse stick was not a claim limitation).

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5. Note: independent claims 40-54 are/appear to be an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. "device which acts or performs ...". (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "**for** providing service level management", carries no patentable weight.

Note that in the claims, the term "**can**" or "**could be modified**" is considered as being "optional" or "capable" or "potential" or not necessarily needed limitation.

Note also that the "**allow**" clause: "to allow a client user to view ...." basically reads "permits/allows the user to do a task" and wherein the "task" is "modification of the information". In other word, "permitting/allowing an action" is different from actually "performing an action". "Allowing", "causing" or "permitting" only requires "serving as the reason" for an "action" though, not necessarily performing the action. This can be

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done by issuing commands or orders, or entering into contracts. So even though the entity may do something later with the equipment that is in the technological arts, the positively recited steps of merely "causing" can be done without operating the equipment and is not in the technological arts. Variations on this theme have been seen in other cases, using terms like "allowing" or "permitting" an action, e.g. "allowing a user to search a database". Again, these functions (elements or steps) are distinct from actually doing the action, e.g. "modifying the input data..." and the current claim language has no such function or structural element calling for "configured to modify" or "step/means for modifying".

As for the limitation "product portfolio performance", "product market", "product innovation ideas", etc., they are considered as non-functional descriptive material (NFDM) on the data of "...", thus having no patentable weight. The mere insertion of "product portfolio performance" data over "data" does not "impart functionality when employed as a computer component", thus having no patentable weight.

See MPEP 2106.01 "Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive

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material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 3-5, 10-12, 30-31, 34-39 (method) are rejected under 35 U.S.C. 101.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office’s guidance to an examiner is that a § 101 process must:

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(a) To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

(b) There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method

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claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

(c) Here, applicant's method steps fail the first prong of the new test because the fact that the only alleged tie, 1st step of "providing a plurality of services over a network..", is directed to insignificant extra solution activities and is insufficient to render the otherwise ineligible process claim as statutory. Furthermore, the term "network" could read over software components or does not have to be an apparatus. Similarly, there is a use of "one monitoring agent" on the monitoring step, but this appears to be software components.

(d) Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



9. Claims 40-54 (system) are rejected under 35 U.S.C. 101 because the claimed invention is directed to more than one class of statutory subject matter.

The independent claim 11 begin by discussing a “system” comprising “a network”, but the body of the claim include method steps, such as “supports”, “provided”, “support”, “measures”, “defines a relationship”, “infers”, “measures”, “defines”, measures”, or respectively use language that is used in the claims of a method. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

Similarly dependent claims 12-18 comprise method steps, such as “fails”, “meeting”, “exceeding”, “support”, “to meet”, “satisfies”, etc., or respectively use language that is used in the claims of a method. "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only". See Ex parte Lyell (17 USPQ2d 1548).

### ***Claim Rejections - 35 USC § 112***

10. **Claims 40-54 (system) are** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) **Claims 40-54 (system)** are vague and indefinite since the claims uses “method steps” such as “supports”, “provided”, “support”, “measures”, “defines a relationship”, “infers”, “measures”, “defines”, measures”, “fails”, “meeting”, “exceeding”,

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“support”, “to meet”, “satisfies”, etc., in an apparatus claims. See IPXL Holdings. Va. Amazon.com (Fed. Circuit 2005). System claim that includes a method step is invalid as indefinite since it's not clear what is the scope of the apparatus claim.

Note: In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See (1) MPEP 2114. (2) *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Apparatus claims cover what a device is, not what a device does, i.e. “device which acts or performs ...”. (3) *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (Fed. Cir. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. (4) *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. **Claims 40-54 (system) and 1, 3-5, 10-12, 30-31, 34-39 (method) are rejected under 35 U.S.C. 103(a) as obvious over BALL et al (US 6,446,200) in view of ENGEL et al.**

**As for independent claims 40 and 1**, BALL et al fairly teaches a system and method for providing service level management of a networking service provided to a business Entity by identifying service parameters, determining the value of the service parameters, monitoring the service parameters, and taking action to change the parameters to restore the service to acceptable level as defined in a service level agreement (SLA), BALL et al discloses a similar method for providing service level management for a business process of an entity associated with a network comprising the steps of:

identifying a plurality of networking services for the Entity in carrying out its business {see Figs. 1 “monitoring a TCP/IP Network”, 3, 4, 5, 30, col. 2, lines 1-10 “*new level of service-services* ... “, col. 31 “service quality”},

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identifying at least 1 of service parameter {i.e. “transmission of data, or flow aggregation and distribution process”, “service quality packet loss”, see cols. 3-4, Figs. 29A, 29B, col. 31, lines 12-67},

determining at least 1 value of a variable associated with at least 1 of the service parameter that indicates a service level {“packet loss”, “availability”, see {col. 31, line 11 to col. 33, line 65},

monitoring the at least 1 value of the variable {see Fig. 29A, col. 29, lines 5-50},  
and

determining the service level in comparison with the level defined in a service level agreement and taking action to meet the agreement level {col. 33, especially col. 34, lines 1-7 “detects, monitors, and audits ... services being delivered”}.

BALL et al appears to teach the claimed invention except for identifying a function that defines a relationship between the component parameter and the service parameter monitoring the component parameter in order to determine the service level.

In a similar system and method for monitoring and managing communications networks for computers, ENGEL et al fairly discloses system and method monitoring and managing communications networks for computers including using network performance statistics to define relationship between the component parameter and the service parameter to provide an **effective and useful** view of network performance and facilitates a quick diagnose of network problems {see col. 4, lines 22-35, see col. 3, lines 15-25 “...generating a **model of the network** based on the monitoring...”, cols. 10-11 “Network Monitor”, Statistics Module (STATS), Figs. 5, 6, 7A-7C, 18-19}.

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Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to modify the teachings of BALL et al to include the elements of ENGEL et al in order to provide an **effective and useful** view of network performance and facilitates a quick diagnose of network problems.

Alternatively, the selection of other service parameters or variables among well known parameters, i.e. components or prices or services (availability, response time, security, etc.) would have been obvious as mere selection of other similar parameters or variables from a limited species of parameters/variables.

As for dep. claims 41-44 (part of 40 above) and 3-5, 31 (part of 1 above), which appear to deal with level determination parameters and level satisfactions, these are taught in BALL et al Figs. 16, 21, 3031 and ENGEL et al Figs. 21 and 22, cols. 15-16, cols. 29-31.

As for dep. claims 45-48 (part of 40 above) and 10-12, 30 (part of 1 above), which appear to deal with level determination parameters and level agreements, these are taught in BALL et al Figs. 16, 21, 3031 and ENGEL et al Figs. 21 and 22, cols. 29-31.

As for dep. claims 49-52 (part of 40 above) and 34-37 (part of 1 above), which appear to deal with decision analysis determination parameters, these are taught in BALL et al Figs. 16, 21, 3031 and ENGEL et al Figs. 19, 20B, 23, and 25.

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As for dep. claims 53-54 (part of 40 above) and 38-39 (part of 1 above), which appear to deal with function analysis determination parameters, these are taught in ENGEL et al Figs. 2, 7A, 7C and cols. 19-20.

***Response to Arguments***

14. Applicant's arguments with respect to the previous claims have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.

No claims are allowed.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

1. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

2. Any response to this action should be mailed to:

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3. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

4. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689

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